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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,530	09/26/2005	Maurizio Galimberti	07040.0212-00000	9263
22852	7590	11/18/2010	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			HAUTH, GALEN H	
ART UNIT	PAPER NUMBER			
		1742		
MAIL DATE	DELIVERY MODE			
11/18/2010	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,530	<b>Applicant(s)</b> GALIMBERTI ET AL.
	<b>Examiner</b> GALEN HAUTH	<b>Art Unit</b> 1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 29 September 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 47 and 50-106 is/are pending in the application.

4a) Of the above claim(s) 85-106 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 47 and 50-84 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/29/2010 has been entered.

### ***Response to Amendment***

2. Acknowledgment is made to applicant's amendment of claim 47.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 47 and 50-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eswaran et al. (PN 5711904) in view of Tauscher et al. (PN 4692030).

a. With regards to claim 47, Eswaran teaches a method for continuously producing an elastomeric composition (abstract) for tires (col 4 ln 48-49) in which, as seen in Figure 2, an elastomer (41) and a filler (43) are fed into a first extruder (48) where the composition is mixed and dispersed. Eswaran teaches discharging and cooling the composition (52) and passing the resulting cooled composition through a second extruder (62), but does not teach that the second mixer comprises a static mixer.

b. Tauscher teaches a static mixing device (abstract) for use downstream of a feed screw extruder prior to a die (col 1 ln 7-19) in order to reduce inhomogeneities in highly viscous melts (col 1 ln 56-59) such as synthetic or natural rubber (col 1 ln 31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the static mixer of Tauscher in at least the second extrusion mixer of Eswaran, because both relate to the extrusion of highly viscous materials with additives presenting a reasonable expectation of success and Tauscher teaches that the static mixer improves the homogeneity of the melt.

c. With regards to claims 50-51, Eswaran teaches interstage cooling (Fig. 2), but does not teach a temperature to which the material is cooled. Eswaran teaches using extruder barrels with temperatures ranging from 50-500 degrees Fahrenheit (col 6 ln 45-48). Thus it would have been obvious to one of ordinary

skill in the art at the time the invention was made to use a material temperature in the process between 50-500 degrees Fahrenheit (10-560 degrees Celsius) including the interstage cooler as this is a temperature range taught by Eswaran for handling the material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the material to 20-90 degrees Celsius through optimization of the material handling temperature range taught by Eswaran, because Eswaran is silent as to a cooling temperature for interstage cooling prompting one of ordinary skill to use the temperature range taught by Eswaran for material handling in the remainder of the process.

- d. With regards to claims 52-54, 56, and 66-67, Eswaran teaches adding coupling agent to the extruder (Col 11 Example 1).
- e. With regards to claim 55, Eswaran teaches including silica (Example 1, a non temperature sensitive ingredient).
- f. With regards to claims 58 and 69, Eswaran teaches using silica with a particle size of nanometers (col 7 In 45-50, powder)
- g. With regards to claims 57, 59-65, 68, 70-76, and 78-81 Eswaran teaches passing the elastomeric material through multiple cycles of the first extruder in which ingredients may be added on each pass and the resulting elastomeric composition is ground into 3/8 inch (9.5 mm) particles and passed through again (col 8 In 50-60, col 9 In 1-10, Col 11 In 25-30, each pass creates a master batch that is ground into a subdivided product before introduction into the extruder and

contains minor ingredients and will be stirred by its passage through the static mixer of Tauscher).

- h. With regards to claim 77, Eswaran teaches discharging the composition as crumbs (col 6 ln 50).
- i. With regards to claim 82, Eswaran in view of Tauscher, as applied to claim 47 above, teaches discharging through a static mixer.
- j. With regards to claims 83 and 84, Eswaran teaches processing in a continuous or batchwise manner (col 8 ln 65-67).

***Response to Arguments***

- 6. Applicant's arguments with respect to claims 47 and 50-84 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

- 7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GALEN HAUTH whose telephone number is (571)270-5516. The examiner can normally be reached on Monday to Thursday 8:30am-5:00pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571)272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GHH/

/Christina Johnson/  
Supervisory Patent Examiner, Art Unit 1742